

Remarks

At present, applicants' claims 1-28 stand rejected under 35 U.S.C. § 101. Claims 1-29 stand rejected under 35 U.S.C. § 112. Lastly, claim 29 stands rejected under 35 U.S.C. § 102 based upon the patent to Robertazzi et al. (US Patent Number 6,370,560 issued on April 9, 2002 based upon an application that was filed on March 13, 1988 which was itself a continuation-in-part of an application filed on September 16, 1996 and now abandoned). In light of the amendments made herein and the comments presented below all of these rejections are respectfully traversed. Accordingly, claims 1-29 remain pending in the present application.

Attention is directed first to the rejection of applicants' claims 1-28 under 35 U.S.C. § 101. In this regard, it is noted that applicants' claim 1 has been amended herein to reflect applicants' intention as reflected in the specification that the claimed method is in fact carried out by and in a data processing system. Accordingly, the rejection of applicants' claim 1 (and the claims that depend therefrom) under 35 U.S.C. § 101 is no longer applicable. Accordingly, it is respectfully requested that this rejection be withdrawn.

Attention is next directed to the rejection of applicants' claim 15 and the claims which depend therefrom under 35 U.S.C. § 101. In this regard, it is noted that applicants' claim 15 is specifically directed to a "program product". This is a claim category specifically authorized by the MPEP, applicable regulations, statutes, and judicial interpretations. In particular, it is noted that applicants' claim 15 is directed to "a program storage device readable by a digital processing apparatus tangibly embodying a program of instructions executable by the digital processing apparatus to perform method steps...". [Emphasis added herein.] Applicant's attorney is well aware of the multitude of cases and decisions cited by the Examiner in the rejection of claim 15. The Examiner incorrectly asserts that applicants' claim 15 is not directed in any way to the

PATENT
IBM Docket No. POU919980157US7

technical arts. However, this characterization is strenuously but respectfully traversed. In particular, the cost capacities associated with migrating from a first computer platform to a second computer platform do represent highly technical considerations involving data processing capacity and its associated cost. In particular, it is denoted that data processing capacity is a physical parameter. In particular, it is noted that it is just as much a physical parameter and measurement of physical information as is the X-ray absorption coefficient for a volume of space occupied by a human subject in a cat-scanning device. Accordingly, both on the level of reciting a program product and on the level of reciting executable program claim steps that involve physical and technical data, it is seen that the claim, as presented, fully falls within the ambit of 35 U.S.C. § 101 as representing patentable subject matter. Accordingly, it is therefore respectfully requested that the rejection of applicants' claim 15 and the claims which depend therefrom under 35 U.S.C. § 101 be withdrawn.

Next is considered the rejection of applicants' claims 1-29 under 35 U.S.C. § 112, second paragraph. In this regard, it is noted that the concerns which the Examiner has raised have been corrected in the amendments herein to claims 1, 15, and 29. Accordingly, these claims are now in full compliance with 35 U.S.C. § 112 and as above, it is also respectfully requested that the rejection of claims 1-29 under 35 U.S.C. § 112 be withdrawn.

Lastly is considered the rejection of applicants' claim 29 under 35 U.S.C. § 102 based upon the patent to Robertazzi et al. Preliminarily, however, it is noted that a rejection under 35 U.S.C. § 102 is a narrow ground of rejection. It requires each and every element of applicants' claims to be found within the four corners of a single document. It is asserted herein that the patent to Robertazzi et al. fails this test.

In particular, it is noted that applicants' claim 29 is directed to a system for determining a cost differential resulting from migrating computational processing

PATENT
IBM Docket No. POU919980157US7

capacity from a first computer platform to a second computer platform. Furthermore, applicants' claim 29 recites the presence of "means for determining an amount of said required processing capacity to be migrated from said first computer platform...". Accordingly, it is clear that applicants' claim 29 contemplates an operation of migration from one platform to another. However, it is noted that in the patent to Robertazzi et al. nowhere is the concept of migration taught, disclosed, or suggested. For this reason alone, it is clear that applicants' claim 29 is not in any way anticipated by the patent to Robertazzi et al.

Furthermore, the Examiner asserts that the controller of Robertazzi 103 reads on applicants' recitation of a means for determining processing capacity. In this respect, it is noted that the controller of Robertazzi determines nothing. It is a controller; it is not a determiner. Furthermore, the Examiner asserts that the description of the invention in Robertazzi et al. as shown in their Figures 1-6 corresponds to applicants' recitation of a "means for deriving a cost capacity measurement for platforms". However, in this regard, it is noted that merely switching computers is not the same thing as switching computer platforms. These are entirely different concepts. Likewise, Robertazzi's description of a means for partitioning the processing capacity does not in any way correspond with applicants' recitation of a migration operation.

Accordingly, for all of the reasons indicated above it is seen that applicants' claim 29 is in no way anticipated by the teachings found within the patent to Robertazzi et al. It is therefore respectfully requested that the rejection of applicants' claim 29 under 35 U.S.C. § 102 be withdrawn.

It is noted that the response herein does not require the payment of any additional fees. Likewise, it is noted that the amendments made herein are being made as of right.

PATENT
IBM Docket No. POU919980157US7

Accordingly, it is now seen that all of the applicants' claims are in condition for allowance. Therefore, early notification of the allowability of applicants' claims is earnestly solicited. Furthermore, if there are any other matters which the Examiner feels could be expeditiously considered and which would forward the prosecution of the instant application, applicants' attorney wishes to indicate his willingness to engage in any telephonic communication in furtherance of this objective. Accordingly, applicants' attorney may be reached for this purpose at the numbers provided below.

Respectfully Submitted,



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